

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)



Applicant's or agent's file reference P04005	FOR FURTHER ACTION See Form PCT/PEA/416	
International application No. PCT/NO2005/000049	International filing date (day/month/year) 11.02.2005	Priority date (day/month/year) 20.02.2004
International Patent Classification (IPC) or national classification and IPC E21B43/32		
Applicant NORSK HYDRO ASA		

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 5 sheets, including this cover sheet.
3. This report is also accompanied by ANNEXES, comprising:
 - a. ☐ sent to the applicant and to the International Bureau a total of sheets, as follows:
 - ☐ sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).
 - ☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.
 - b. ☐ (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

Date of submission of the demand 05.09.2005	Date of completion of this report 14.02.2006
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**INTERNATIONAL PRELIMINARY REPORT
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International application No.
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Box No. I Basis of the report

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):*

Description, Pages

1-7 as originally filed

Claims, Numbers

1-9 as originally filed

Drawings, Sheets

1/2, 2/2 as originally filed

☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages
- ☐ the claims, Nos.
- ☐ the drawings, sheets/figs
- ☐ the sequence listing (*specify*):
- ☐ any table(s) related to sequence listing (*specify*):

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages
- ☐ the claims, Nos.
- ☐ the drawings, sheets/figs
- ☐ the sequence listing (*specify*):
- ☐ any table(s) related to sequence listing (*specify*):

* If item 4 applies, some or all of these sheets may be marked "superseded."

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Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-9
	No: Claims	
Inventive step (IS)	Yes: Claims	1-9
	No: Claims	
Industrial applicability (IA)	Yes: Claims	1-9
	No: Claims	

2. Citations and explanations (Rule 70.7):

see separate sheet

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

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Reference is made to the following document/s/:

D1 = WO 92/08875 A

D2 = EP 1 050 338 A

Re Item V

**Reasoned statement with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement**

V-1 D1, which is considered as the closest prior art, describes a method as in the preamble of claim 1.

The features in the characterizing par of claim 1 are new and the claim meets the novelty requirement of Art. 33(2) PCT.

V-2 A problem in the method according to D1 is that the downhole choke unit is controlled from the surface, implying therefore the transmission of signals from the surface to the choke and in the opposite direction. By the method according to claim 1 the actuator is at the contrary automatically controlled by changes in the formation fluid property, without any need of control from the surface. While actuators controlled by an osmotic cell are in themselves known (see for example D2), none of the cited documents suggests the particular use and features specified in claim 1.

Claim 1 meets therefore the inventive step requirement of Art 33(3) PCT.

The same conclusion applies to corresponding independent apparatus claim 4 and respective dependant claims (2 to 4 and 6 to 9).

Re Item VII

Certain defects in the international application

VII-1 Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in D2 is not mentioned in the description, nor is said document identified therein.

Re Item VIII

Certain observations on the international application

VIII-1 The expression "in connection" as used at the beginning of claims 1 and 4 is not clear. Expressions as "a method to operate an actuator" and "an actuator device to regulate a fluid flow" should have been used in claims 1 and 4 respectively.

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